



MAR 06 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Carl A. Forest
PATTON BOGGS LLP
867 Coal Creek Circle #200
Louisville, CO 80027

In re Application of
RUMP, Niels *et al*
U.S. Application No.: 09/913,695
PCT No.: PCT/EP99/09977
Int. Filing Date: 15 December 1999
Priority Date: 16 February 1999
Attorney Docket No.: 13189.136
For: METHOD AND DEVICE FOR
GENERATING AN ENCRYPTED USER
DATA STREAM . . .

Response Due for
5/6/02 Reconsideration
Due Date: _____
Statutory Deadline: 9/6/02
Date Docketed: 3/13/02
Docketed by: PA
Sec: ECV en
Atty: CAF

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision the papers filed on 11 January 2002 which have been treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 16 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond.

On 11 January 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, the \$130.00 surcharge fee and a declaration signed by two of the three co-inventors.

On 25 February 2001, after discussing the above-captioned application with James Thomson of the PCT Legal Office, applicants submitted via facsimile documents purportedly mailed on 19 December 2001 which included a "Supplement to Statement of Facts" ("Supplement").

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

The required petition fee of \$130.00 as set forth in 37 CFR 1.17(i) has been paid. Therefore, item (1) is complete. Regarding item (3), the last known address of the inventor who cannot be located, Mr. Rump is listed as:

Brueckenstrasse 13
Erlagen D-91056
Germany

Concerning item (4), section 409.03(a)(A) of the MPEP (8th Ed.) states, in part:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants included a declaration signed by two of the three co-inventors. All the co-inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the MPEP, and is in compliance with 37 CFR 1.497(a) and (b). Therefore, item (4) is satisfied

Concerning item (2), applicants included a "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor (37 C.F.R. Section 1.47)" in the petition which states that the person making the statement of facts was Fritz Schoppe and claims that he has "first-hand knowledge of the facts recited therein." However, this document contained no details on the efforts used to reach Mr. Rump at all and was not signed by Mr. Schoppe.

Counsel also submitted via facsimile on 25 February 2002, a copy of an unsigned Supplement listing the efforts used by the 37 CFR 1.47(a) applicant to locate Mr. Rump. Applicants included copies of the documentary evidence in the German language discussed in the body of facts in the Supplement.

Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the MPEP (8th Ed.) which states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. (Emphasis added).

Applicants listed the steps used to locate Niels Rump in the Supplement including sending letters to Mr. Rump's last known address, a letter to the family of Mr. Rump, a request to the registration office in Erlangen and a telephone inquiry concerning Mr. Rump. This would be sufficient to demonstrate that a diligent effort was made to locate Mr. Rump if it was properly authenticated.

However, the Supplement was not signed by a person who has firsthand knowledge of the details as required by the MPEP. Therefore, the Supplement will not be considered. Moreover, the documentary evidence is in German without an accompanying English translation and also will not be considered. Applicants must submit English translations of any foreign language documents for them to be considered. Accordingly, applicants have failed to meet the requirements of item (2).

Therefore, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

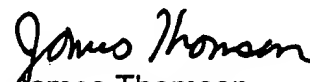
The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457